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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,541	01/29/2001	Robert M. Caruso	6909-5	9250
20575	7590	02/09/2007	EXAMINER	
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			JEAN GILLES, JUDE	
		ART UNIT		PAPER NUMBER
				2143
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/772,541	CARUSO ET AL.	
	Examiner	Art Unit	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4, 6-17, 20-42, 44, 46-48 and 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 6-17, 20-42, 44, 46-48 and 51 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 January 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

This Action is in regards to the Reply received on 11/20/2006.

### ***Response to Amendment***

1. This action is responsive to the Reply filed on 11/20/2006.

Claims 1-44 and 47, 48, and 51 are pending. Claims 1, 14, 20, 21, 23, and 42 are amended. Claims 5, 18, 19, 43, 45, 49-50 are cancelled. Claims 1-4, 6-17, 20-42, 44, 46-48, and 51 represent a "rich media file format and delivery methods" and remain in the case for consideration.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 14, 20, 21, 23, and 42 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following existing ground of rejection as explained here below.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated. Because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

- A. Both Martin and Leonard patents fail to disclose or suggest a viewer applet contained with the message itself in a single file.

B. Applicant contends that combining the self-executable image file of Martin with the message of Leonard would render Leonard's invention unsatisfactory for its intended purpose. If the message of Leonard included the viewer code as taught by Martin, there would be no need for the (separate) viewer applet. But if the viewer code is included with the message, then anyone who receives the message automatically receives the viewer code, and is therefore able to view the message.

C. Applicants contend that claim 26 for instance recites a unitary rich media file designed to leave no footprint on a user's system when removed, and that Leonard does not teach that its email message/viewer applet leaves no footprint on a user's system when removed.

As to "Point A" it is the position of the Examiner Both Martin and Leonard patents in detail teaches the a viewer applet contained with the message itself in a single file. Lenard discloses "*Although illustrated as discrete entities in FIG. 1, the message origination software 2 and viewer applet 4 are preferably integrated into a single program or applet, as will be explained in more detail below..." and further..*" *The user interfaces for the message origination software and viewer applet may be designed to be similar to that of a conventional electronic mail program. Preferably, the viewer and origination software are combined into a single program, although certain features of the message origination software, such as the expiration date and ability to insert processing or handling controls, ...*" (column 14, lines 40-50, and column 18, lines 50-60;

See rejection of claim for the disclosure of Martin in a single file with viewer and data in a single file).

As to "Point B", Motivation to combine is provided in the rejection of claim 1; and as to point C, it is obvious that removing or deleting as single file in order of the file to leave no footprint in the system is not a novelty and that an ordinary skill in the art understands that removing the single program or file of Martin or Leonard or any other file would accomplish the same result.

Examiner notes with delight that no new matter has been added and that the new claims are supported by the application as filed. However, applicant has failed in presenting claims and drawings that delineate the contours of this invention as compared to the cited prior art. Applicant has failed to clearly point out patentable novelty in view of the state of the art disclosed by the references cited that would overcome the 103(a) rejections applied against the claims, the rejection is therefore sustained.

In response to Applicant's arguments, 37 CFR § 1.11(c) requires applicant to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must show the amendments avoid such references or objections."

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-4, 6-17, 20-42, 44, 46-48, and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard et al. (Leonard), Patent No. 6,721,784 B1, in view of Martin et al (Martin), U.S. Patent No: 6,272,484 B1.

Regarding **claim 1**, Leonard teaches the invention substantially as claimed. Leonard discloses a rich media file stored in a machine-readable medium (fig. 6, item 2), comprising:

information to be displayed on a computer system , the information including text and at least one image (column 18, lines 51-67; column 19, lines 1-15); and a viewer desired to display the information on the computer system, the information and the viewer contained in a single file (see Leonard; column 9, lines 23-30; column 14,lines 40-67); and checking means for checking if there is a later version of the rich media file (see Leonard; column 13, lines 32-55; column 12, lines 51-67). However, applicant's contends that Leonard does not specifically disclose all the details of a viewer designed to display information including text and at least an image, the information and the viewer contained in a single file.

In the same field of endeavor, Martin discloses “ ... a copy 619 of data of the stored image file 601 may be combined with viewer code 621 to form a self-contained executable viewer application 623. Self-contained executable viewer application 623 may be executed to view the visual representation of image file 601... The user has the

*option of adding annotations 617 to stored image file 601 to help memorialize any thoughts or comments the user may have. The user also has the option of creating a self-contained executable viewing application 623 including a copy of data of the stored image file 619 and executable viewer code 621. The user has the option of archiving or providing another user with a copy of stored image file 601 or the self-contained executable viewing program 623...[see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; and abstract].*

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Martin's teachings of a technique including a message and a viewer contained in a single file, with the teachings of Leonard, for the purpose of "*allowing control of viewing and handling of the electronic field message and allowing the user to view the message using the applet viewer...*" as stated by Leonard in lines 51-55 of column 14. Martin provides motivation to combine as well by stating in column 2, lines 58-62 that "*...this method enable a first user to provide a second user wit a web page image as originally viewed by the first user...*". By this rationale **claim 1** is rejected.

Regarding **claim 2**, The combination Leonard-Martin discloses a rich media file according to claim 1, further comprising limit means for limiting viewing of the rich media file (see Leonard; column 14, lines 40-67; column 15; lines 1-61).

Regarding **claim 3**, The combination Leonard-Martin discloses a rich media file according to claim 2, wherein the limit means is selected from a setting defining a predetermined number of viewings of the information, a setting defining a

predetermined number of days, a predetermined expiration date, and a password controlling access to the rich media file (see Leonard; column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 4**, The combination Leonard-Martin discloses a rich media file according to claim 2, wherein limit means is designed to expire the rich media tile, and rich media file is designed so that it cannot be viewed after the rich media file has expired (see Leonard; column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 6**, The combination Leonard-Martin discloses a rich media file according to claim 1, further comprising a query asking a user if the user would like to retrieve a later version of the rich media file (see Leonard; column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 7**, The combination Leonard-Martin discloses a rich media file according to claim 1, further comprising retrieval means for retrieving a later version of the rich media file (see Leonard; column 13, lines 32-55; column 12, lines 51-67).

**Regarding claim 8**, the combination Leonard-martin teaches the rich text file wherein the information is compressed using a compression technique to reduce the size of the rich media file [see Martin; column 6, lines 55-67; column 7, lines 1-33].

Regarding **claim 9**, The combination Leonard-Martin discloses a rich media file according to claim 1, the rich media file further comprising a unique file identification in addition to a file name (see Leonard; column 10, lines 56-67).

Regarding **claim 10**, The combination Leonard-Martin discloses a rich media file according to claim 1, wherein the information is formatted into a plurality of pages (see Leonard; column 16, lines 27-54).

Regarding **claim 11**, the combination of Leonard- Martin discloses a rich media file according to claim 10, wherein the information includes a link from a first page of the information to a second page of the information [see Martin, column 1, lines 29-56].

Regarding **claim 12**, The combination Leonard-Martin discloses a rich media file according to claim 1, wherein the viewer includes only a capability desired by a builder of the rich media file (see Leonard; column14, lines 41-67).

Regarding **claim 13**, the combination of Leonard- Martin discloses a rich media file stored in a machine-readable medium, comprising:

information to be displayed on a computer system, the information compressed using a compression technique [see Martin; column 6, lines 55-67; column 7, lines 1-33]; a viewer designed to display the information on the computer system [see Leonard; column 9, lines 23-30; column 14,lines 40-67];

limit means for limiting viewing of the rich media file, the limit means drawn from a setting defining a predetermined number of viewings of the information, a setting defining a predetermined number of days, a predetermined expiration date, and a password controlling access to the rich media file [see Leonard; column 16, lines 12-26; column 17, lines 32-56];

checking means for checking if there is a later version of the rich media file [see Leonard; column 13, lines 32-55; column 12, lines 51-67];

a query asking a user if the user would like to retrieve the later version of the rich media file [see Leonard; ];  
retrieval means for retrieving the later version of the rich media file [see Leonard; ]; and  
a unique file identification for the rich media file in addition to a file name [see Leonard;  
column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 14**, the combination of Leonard- Martin discloses a method for retrieving a rich media file, the method comprising:

selecting a link on a network [see Martin, column 1, lines 29-56];  
downloading the rich media file over the network based on a unique file identification other than the link and other than a file name [see Leonard; column 10, lines 56-67];  
and  
saving the rich media file on a computer system [see Leonard; column 18, lines 51-67].  
opening the rich media file using a viewer built into the rich media file [see Leonard;  
column 13, lines 32-55; column 12, lines 51-67].

checking means for checking if there is a later version of the rich media file (see Leonard; column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 15**, the combination of Leonard- Martin discloses a method according to claim 14, wherein selecting a link includes transmitting the unique file identification over the network [see Leonard; column 10, lines 56-67].

Regarding **claim 16**, the combination of Leonard- Martin discloses a method according to claim 14, wherein downloading the rich media file over the network from a remote server includes downloading the rich media file over the network from a remote server different from a second server that includes the link [see Martin; fig. 3, items 309, and 311].

Regarding **claim 17**, the combination of Leonard- Martin discloses a method according to claim 14, wherein downloading the rich media file includes downloading an earlier version of the rich media file [see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; and abstract].

Regarding **claim 20**, the combination of Leonard- Martin discloses a method according to claim 14, wherein asking a user if the user would like to retrieve the later version of the rich media file includes[see Leonard; column 13, lines 32-55; column 12, lines 51-67];

if the user requests the later version of the rich media file [see Leonard; column 13, lines 32-55; column 12, lines 51-67];

downloading the later version rich media file; and

opening the later version of the rich media file using a viewer built into the later version of the rich media file[see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 21**, the combination of Leonard- Martin discloses a method according to claim 14, wherein opening the rich media file includes:

checking to see if the lich media file has expired [see Leonard; column 16, lines 12-26; column 17, lines 32-56]; and

if the rich media file has expired, asking the user if a later version of the rich media file or chained file is desired [see Leonard; column 16, lines 12-26; column 17, lines 32-56].

Regarding **claim 22**, the combination of Leonard-Martin discloses a method according to claim 21, wherein checking to see if the rich media file has expired includes refusing to open the lich media file if the rich media file has expired [see Leonard; column 16, lines 12-26; column 17, lines 32-56].

Regarding **claim 23**, the combination of Leonard-Martin discloses a method according to claim 18, wherein opening the rich media file includes:

prompting for a password; and refusing to open the rich media file if the password is not provided [see Leonard; column 16, lines 12-43].

Regarding **claim 24**, the combination of Leonard-Martin discloses a method according to claim 14, the method further comprising deleting the rich media file, thereby leaving no footprint on the computer system [see Leonard, column 18, lines 34-65; fig. 15].

Regarding **claim 25**, the combination of Leonard-Martin discloses a computer-readable medium containing a program to retrieve a rich media file, the program being executable on computer system to implement the method of claim 14 [see Leonard; column 13, lines 32-55; column 12, lines 51-67];

Regarding **claim 26**, the combination of Leonard-Martin discloses a method for building a unitary lich media file, the method comprising:

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assembling information for the unitary rich media file [see Leonard; column 17, lines 18-56];

formatting the information [see Leonard; column 17, lines 18-56];

coupling the information with a viewer [see Leonard; column 9, lines 23-30; column 14, lines 40-67]; and

converting the information and the viewer to the unitary rich media file [see Leonard; column 9, lines 23-30; column 14, lines 40-67], so that the unitary rich media file is designed to leave no footprint on a user's system when removed [see Martin, column 7, lines 16-30].

Regarding **claim 27**, the combination of Leonard-Martin discloses a method according to claim 26, wherein formatting the information includes placing the information on a plurality of pages [see Leonard; column 16, lines 27-54].

Regarding **claim 28**, the combination of Leonard-Martin discloses a method according to claim 27, wherein formatting the information further includes placing a link on a first page of the information to a second page of the information [see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; and abstract].

Regarding **claim 29**, the combination of Leonard-Martin discloses a method according to claim 26, wherein formatting the information includes selecting viewing options to include with the rich media file [see Leonard; column 14, lines 41-67].

Regarding **claim 30**, the combination of Leonard-Martin discloses a method according to claim 26, wherein formatting the information includes assigning expiration parameters to the rich media file [see Leonard; column 16, lines 12-26; column 17, lines 32-56].

Regarding **claim 31**, the combination of Leonard-Martin discloses a method according to claim 26, wherein formatting the information includes placing the information into a platform-independent intermediary state [see Martin, summary].

Regarding **claim 32**, the combination of Leonard-Martin discloses a method according to claim 26, wherein coupling the information with a viewer includes coupling the information with the viewer for a particular computer platform [see Martin, summary].

Regarding **claim 33**, the combination of Leonard-Martin discloses a method according to claim 26, wherein converting the information includes formatting the information from an intermediate file format to a format for display in the rich media file, the format for display designed to work with the viewer on a particular platform [see Martin, summary].

Regarding **claim 34**, the combination of Leonard-Martin discloses a method according to claim 26, wherein converting the information includes compressing an image in the information [see Leonard; column 9, lines 23-30; column 14, lines 40-67];

Regarding **claim 35**, the combination of Leonard-Martin discloses a method according to claim 26, wherein converting the information includes converting the information to the rich media file at a server not owned by a client building the rich media file [see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; and abstract].

Regarding **claim 36**, the combination of Leonard-Martin discloses a method according to claim 26, the method further comprising:

storing the rich media file on a server [see martin, fig 3]; and  
placing a link to the rich media file on a web page over a computer network [see Leonard; column 6, lines 43-60].

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Regarding **claim 37**, the combination of Leonard-Martin discloses a method according to claim 36, wherein storing the rich media file includes assigning the rich media file a unique file identification in addition to a file name [see Leonard; column 10, lines 56-67].

Regarding **claim 38**, the combination of Leonard-Martin discloses a method according to claim 37, wherein placing a link includes using the unique file identification in the link [see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; and abstract].

Regarding **claim 39**, the combination of Leonard-Martin discloses a method according to claim 36, wherein storing the rich media file includes storing the rich media file on a server different from the one storing the link [see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; and abstract].

Regarding **claim 40**, the combination of Leonard-Martin discloses a method according to claim 36, wherein storing the rich media file includes retaining an earlier version of the rich media file on the server [see Martin; column 9, lines 62-67; column 10, lines 1-33; fig. 6; abstract and fig. 3].

Regarding **claim 41**, the combination of Leonard-Martin discloses a computer-readable medium containing a program to retrieving a rich media file, the program being executable on a computer system to implement the method of claim 26 [see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 42**, The combination Leonard-Martin discloses a memory for storing a platform-independent rich media file including a data structure stored in said memory, comprising:

information for the rich media file (see Leonard; column 18, lines 51-67; column 19, lines 1-15);

a unique identification for the rich media file (see Leonard; column 10, lines 56-67);

a version number for the rich media tile (see Leonard; column 13, lines 32-55; column 12, lines 51-67); and

at least one viewing option for the rich media file (see Leonard; column 9, lines 23-30; column 14, lines 40-67); and

a client identification for a client creating the rich media file (see Leonard; column 20, lines 50-61; column 10, lines 56-67).

Regarding **claim 44**, The combination Leonard-Martin discloses a memory according to claim 42, wherein the data structure further includes expiration features (see Leonard; column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 46**, The combination Leonard-Martin discloses a memory for storing a database of rich media files including a data structure stored in said memory, comprising:

a rich media file (see Leonard; column 18, lines 51-67; column 19, lines 1-15);

a profile of a user who downloaded the rich media file (see Leonard; column 12, lines 50-67);

a client who generated the rich media file (see Leonard; column 14, lines 1-67); and

a log storing a transaction in the data structure (see Leonard; column 12, lines 50-67).

Regarding **claim 47**, The combination Leonard-Martin discloses a memory according to claim 46, the data structure further including a mapping from the rich media file to the client (see Leonard; column 14, lines 40-67).

Regarding **claim 48**, the combination of Leonard-Martin discloses a memory according to claim 46, the data structure further including an auto-notification for the user when the rich media file is updated [see Martin; column 9, lines 62-67; column 10, lines 1-67; fig. 6; and abstract].

Regarding **claim 51**, the combination of Leonard-Martin discloses a rich media file according to claim 13, wherein the information further includes text.

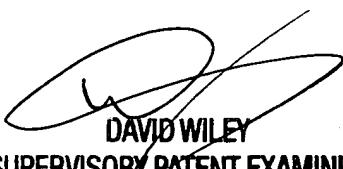
***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles  
Patent Examiner  
Art Unit 2143



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

JJG

February 04, 2007